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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/09/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,031

Applicant(s)

ERICKSEN, MARY A.

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 23-28 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 9, 14, 29 and 34 is/are objected to.
- 8) ☒ Claim(s) 15-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawn Rejection

1. The 35 U.S.C. 112 rejections of claims 2, 6 – 9, 11 – 14, 26 – 29 and 31 in Paper #6, Pages 2 – 3, Paragraphs #3 – 4 are withdrawn due to Applicant's arguments in Paper #8.
2. The 35 U.S.C. 102 rejection of claims 1 – 3, 6 – 8, 10 – 13, 23 – 28 and 30 as anticipated by May in Paper #6, Pages 3 – 5, Paragraph #6 is withdrawn due to Applicant's arguments in Paper #8.
3. The 35 U.S.C. 103 rejection of claims 4, 5 and 31 – 33 over May in view of Carte et al. in Paper #6, Pages 5 – 7, Paragraph #6 is withdrawn due to Applicant's arguments in Paper #8.
4. The 35 U.S.C. 103 rejection of claims 9, 14 and 29 over May in view of Crandall et al. in Paper #6, Pages 7 – 8, Paragraph #6 is withdrawn due to Applicant's arguments in Paper #8.

New Rejection

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1772

6. Claims 1, 2 and 6 – 8 are rejected under 35 U.S.C. 102(b) as being anticipated by May (USPN 4,648,689).

3/8/33

May discloses a tape with an adhesive side (Figure 2, #3 and Column 3, lines 38 – 39) and a non-adhesive side (Figure 1, #4) where the adhesive is a pressure sensitive adhesive (Column 5, lines 13 – 18) which sticks to the surface to which it is applied (Column 5, lines 19 – 24). The tape is formed from a closed-cell cross-linked foam material chosen from a variety of materials including polyurethane, silicone rubber, ethylene propylene diene terpolymer or neoprene (Column 3, lines 34 – 37). A layer of reflective microspheres, glass beads with an aluminum coating (Column 3, lines 47 – 49), are attached to the non-adhesive side of the tape by embedding the spheres in the surface of a polymeric sheet (Column 3, lines 44 – 47). Since May discloses the glass beads embedded on the non-adhesive side of the tape (Column 3, lines 47 – 49) as claimed by the applicant, it is inherent that the reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 abrasion cycles.

7. Claims 10 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshitaka (JP 3,193,440).

Yoshitaka discloses a foam backing with first and second sides (Abstract, line 5 and Figure 1, #14). A layer of retroreflective, glass, beads are partially embedded in the first side of the backing (Abstract, lines 6 – 8 and Figure 1, #13). Since Youshitaka discloses the glass beads embedded on the non-adhesive side of the foam backing (Abstract, lines 6 – 8 and Figure 1, #13)

Art Unit: 1772

as claimed by the applicant, it is inherent that the reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 abrasion cycles.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 6 – 8, 23 – 28, 30 and 31 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of Yoshitaka.

May discloses a tape with an adhesive side (Figure 2, #3 and Column 3, lines 38 – 39) and a non-adhesive side (Figure 1, #4) where the adhesive is a pressure sensitive adhesive (Column 5, lines 13 – 18) which sticks to the surface to which it is applied (Column 5, lines 19 – 24). The tape is formed from a closed-cell cross-linked foam material chosen from a variety of materials including polyurethane, silicone rubber, ethylene propylene diene terpolymer or neoprene (Column 3, lines 34 – 37). A layer of reflective microspheres, glass beads with an aluminum coating (Column 3, lines 47 – 49), are attached to the non-adhesive side of the tape by embedding the spheres in the surface of a polymeric sheet (Column 3, lines 44 – 47). However, May fails to disclose the tape being a medical tape having a foam backing, a foam backing including a first and second side, coating the first side with a pressure sensitive adhesive,

Art Unit: 1772

covering the second side with retro reflective beads, applying heat and pressure to embed the beads into the second side of the foam and laminating the beads to the second side.

Yoshitaka teaches a foam backing having first and second sides (Abstract, line 5 and Figure 1, #14) with a layer of retroreflective, glass, beads are partially embedded in the first side of the backing (Abstract, lines 6 – 8 and Figure 1, #13) in a decorative sheets for the purpose of a sheet that has good resilience and an evenly arranged beads which gives a good gloss when light reflects off the surface.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the foam backing in May in order to make a sheet that has good resilience and an evenly arranged beads which gives a good gloss when light reflects off the surface as taught by Yoshitaka.

One of ordinary skill in the art would have recognized the claimed retroreflective article would have a reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 abrasion cycles since both May and Yoshitaka teach foam articles with glass beads embedded in the surface. Therefore, one of ordinary skill in the art would have readily determined the optimum reflective brightness after the abrasion cycles depending on the end desired results in the absence of unexpected results.

Art Unit: 1772

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since May teaches a tape with an adhesive side and Yoshitaka teaches a sheet with adhesive side, the structural limitations of the claimed invention are met.

Regarding coating the first side with a pressure sensitive adhesive, covering the second side with retro reflective beads, applying heat and pressure to embed the beads into the second side of the foam and laminating the beads to the second side in claims 24 and 25, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of coating, cover and applying heat and pressure are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence

Art Unit: 1772

from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

10. Claims 1 – 2, 4 – 8, 23 – 28, 30 and 31 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshitaka in view of Carte et al. (USPN 5,947,917).

Yoshitaka discloses a foam backing having first and second sides (Abstract, line 5 and Figure 1, #14) with a layer of retroreflective, glass, beads are partially embedded in the first side of the backing (Abstract, lines 6 – 8 and Figure 1, #13) in a decorative sheets for the purpose of a sheet that has good resilience and an evenly arranged beads which gives a good gloss when light reflects off the surface. Yoshitaka fails to disclose a pressure sensitive adhesive on the adhesive side of the tape, the tape being medical tape capable of being comfortably adhered to human skin, the tape having a nonwoven backing, covering the second side with retro reflective beads, applying heat and pressure to embed the beads into the second side of the foam and laminating the beads to the second side.

Carte et al. teaches a foam (Column 2, lines 64 – 67) or non-woven backing material (Column 3, lines 44 – 52) in a medical tape (Column 3, lines 31 – 34) with a pressure sensitive adhesive coated on one of the sides of the backing material (Column 3, lines 25 – 28 and Column 5, lines 33 – 41) for the purpose of easy removal of the tape from a surface.

Art Unit: 1772

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the medical tape formed with either foam non-woven backing material with a pressure sensitive adhesive in May in order to easily remove the tape from a surface.

One of ordinary skill in the art would have recognized the claimed retroreflective article would have a reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 abrasion cycles since both May and Yoshitaka teach foam articles with glass beads embedded in the surface. Therefore, one of ordinary skill in the art would have readily determined the optimum reflective brightness after the abrasion cycles depending on the end desired results in the absence of unexpected results.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since May teaches a tape with an adhesive side and Yoshitaka teaches a sheet with adhesive side, the structural limitations of the claimed invention are met.

Art Unit: 1772

Regarding coating the first side with a pressure sensitive adhesive, covering the second side with retro reflective beads, applying heat and pressure to embed the beads into the second side of the foam and laminating the beads to the second side in claims 24 and 25, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of coating, cover and applying heat and pressure are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Allowable Subject Matter

11. Claims 9, 14, 29 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments with respect to claims 1, 2, 4 – 14 and 23 - 33 have been considered but are moot in view of the new ground(s) of rejection. However, since May is being used in the rejections above, the arguments will be addressed below.

In response to applicant's argument that May fails to teach the reflective beads embedded in the non-adhesive side of the tape, May does disclose the beads being embedded in the surface of the tape (Column 3, lines 44 – 49). The fact that May includes additional structure, i.e. more layers, is irrelevant.

In response to Applicant's argument that May does not include certain features of the Applicant's invention, i.e., the brightness of the particles after abrasion, the limitations on which the Applicant relies (i.e., the effectiveness of the bonding between the backing and the beads) are not stated in the claims. It is the claims that define the claimed invention. Therefore, since both May and the Applicant's invention use glass beads as their retroreflective elements, it would be an inherent property of the beads to be able to withstand the abrasion cycles to have a final reflective brightness of 70 of 90%.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-

Art Unit: 1772

5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

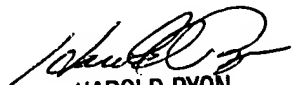
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln

June 3, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER

1772

6/4/03